

U.S. Patent Application Serial No. 10/806,337
Amendment filed August 30, 2005
Reply to OA dated June 21, 2005

REMARKS

Claims 1 - 3 have been canceled without prejudice or disclaimer. Claims 4 - 6 have been added in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. The applicant respectfully submits that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated June 21, 2005.

Added claims 4 - 6 are currently pending in this patent application, claims 4 and 5 being independent claims.

Claims 1 - 3 stand rejected under 35 USC §112, second paragraph, for the specific reasons set forth in item 3, page 2 of the outstanding Action. The applicant respectfully requests reconsideration of this rejection.

As indicated above, claims 1 - 3 have been canceled without prejudice or disclaimer. Thus, the outstanding rejection of these claims is now moot. In place of canceled claims 1 - 3, claims 4 - 6 have been added in order to more particularly point out, and distinctly claim the subject matter to which the applicant regards as his invention, and in order to correct certain informalities therein,

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including those pointed out by the Examiner with respect to claims 1 - 3.

Accordingly, the withdrawal of the outstanding indefiniteness rejection under 35 USC §112, second paragraph, is in order, and is therefore respectfully solicited.

As to the merits of this case, claims 1 - 3 are rejected as follows:

(1) claims 1 - 3 stand rejected under 35 USC §103(a) based on Elliott (U.S. Patent No. 2,349,033) in view of Cherrington (U.S. Patent No. Re.33,793); and

(2) claims 1 - 3 stand rejected under 35 USC §103(a) based on Duke (U.S. Patent No. 4,384,624) in view of Tenbusch II (U.S. Patent No. 5,816,745) in view of Cherrington.

The applicant respectfully requests reconsideration of these rejections.

With respect to the primary reference of Elliott, this patent is concerned with the use of a boring head through a ground from one opening thereof to another for burying types. Elliott utilizes a reciprocable working head 30 against a block 27 for applying hammer blows to a rod in rapid succession, the hammer receiving compressed air for its actuation through a hose 31. However, Elliott lacks any teaching of a reamer because Elliott is merely concerned with the pipe being drawn into a completed bore 24 by attaching its end to the forward end of a rod 26 into the ground opening 22 by means of a suitable coupling 32.

Although the secondary reference of Cherrington teaches the use of a reamer 48 having cutting teeth 50 thereon^{1/}, there is no teaching of a reamer suitable for the type of soil that is being bored. As now clearly set forth in independent claim 4, as filed herewith, the applicants' claimed reamer is selected based on its suitability for the type of soil being bored by selecting a platy member, a teaching which is lacking in the Cherrington patent.

As to the primary reference of Duke, the Examiner has clearly acknowledged that Duke:

- (1) "does not include platy members"; and
- (2) "does not install his pipe by rotating means."^{2/}

The Examiner then relies on the teachings of "plural fins 34" from the Tenbusch II patent for teaching, according to the Examiner, the applicants' use of platy members for attaching to the applicants' reamers.

The applicants submit, however, that in lines 48 - 53, column 5, in Tenbusch II, the plural fins 34 "fastened to the finned member 32 function to fracture or crack the old pipe sections 10 when forced therethrough." Based on such teachings in Tenbusch II, this patent is not concerned with the

^{1/} See, lines 32-35, column 8 in Cherrington.

^{2/} See, lines 1 and 2, page 4 of the outstanding Action.

U.S. Patent Application Serial No. 10/806,337
Amendment filed August 30, 2005
Reply to OA dated June 21, 2005

selection of platy members that would make the reamer suitable for the type of soil being bored. Also, there is no teaching in Tenbusch II that the reamer thereof can be varied based on the selected platy member.

In view of the above, it is the applicant's position that the applicant's claimed method step of selecting at least a platy member suitable for a soil type from among the various types of platy members based on the type of soil to be bored.(as now set forth in added independent claim 4) or the applicant's claimed method step of selecting at least a reamer suitable for a soil type from among the various types of reamers based on the type of soil to be bored (as now set forth in added independent claim 5) are not disclosed in any of the cited prior art references, singly or in combination.

Accordingly, even if, *arguendo*, the teachings of the cited prior art references can be combined in the manner suggested by the Examiner, such combined teachings would still fall far short in fully meeting the applicant's claimed invention, as now set forth in each of independent claims 4 and 5 (and claim 6 which depends from claim 5). Thus, a person of ordinary skill in the art would not have found the applicant's claimed invention, as now recited in claims 4 - 6, obvious under 35 USC §103(a) based on Elliott (U.S. Patent No. 2,349,033) in view of Cherrington (U.S. Patent No. Re.33,793) or under 35 USC §103(a) based on Duke (U.S. Patent No. 4,384,624) in view of Tenbusch II (U.S. Patent No. 5,816,745) in view of Cherrington.

U.S. Patent Application Serial No. 10/806,337
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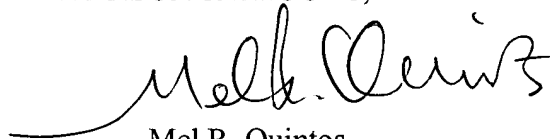
In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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